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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92053703
Party	Defendant Nature's Grilling Products LLC dba NRG International LLC
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Attachments	Royal Oak - Nature's Grilling's Answer to Royal Oak's Petition to Cancel.pdf ( 9 pages )(120636 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Registration No.: 3,221,991  
Mark: NATURE’S MESQUITE (& design)  
Registered: March 27, 2007

In re Registration No.: 3,925,901  
Mark: NATURE’S GRILLING (& design)  
Registered: March 1, 2011

ROYAL OAK ENTERPRISES, LLC,	)	
	)	
	)	
Petitioner,	)	
	)	
vs.	)	Cancellation No. 92053703
	)	
NATURE’S GRILLING PRODUCTS LLC,	)	
dba NRG INTERNATIONAL LLC,	)	
	)	
Registrant.	)	
	)	

**ANSWER TO PETITION TO CANCEL**

COMES NOW, NATURE’S GRILLING PRODUCTS, LLC, dba NRG INTERNATIONAL, LLC, (hereinafter “Nature’s Grilling”), Registrant in the above styled action and states the following as its answer to Petitioner ROYAL OAK ENTERPRISES, LLC’s (hereinafter “Royal Oak”) Petition to Cancel:

**FIRST DEFENSE**

Royal Oak fails to state a claim upon which relief can be granted.

**SECOND DEFENSE**

Royal Oak’s claims for equitable relief are barred by the doctrine of laches.

### **THIRD DEFENSE**

Royal Oak's claims for equitable relief are barred because of Royal Oak's acquiescence to any allegedly unlawful actions.

### **FOURTH DEFENSE**

Royal Oak's claims are barred by the doctrine of waiver.

### **FIFTH DEFENSE**

Royal Oak's claims are barred by the doctrine of estoppel.

### **SIXTH DEFENSE**

Some or all of Royal Oak's claims are barred because Royal Oak's alleged predecessor, Royal Oak Sales, Inc. ("Royal Oak Sales"), committed fraud on the United States Patent and Trademark Office ("USPTO") when filing the Section 8 Declaration/Section 9 Application for Renewal with USPTO on August 3, 2007. At that time, the identification of goods and services listed in the '298 registration included "charcoal briquets, *wood briquets*, wood chips, grill wood and fire starting fiberboard."

On August 3, 2007, Royal Oak Sales stated the following in the Declaration/Application for Renewal:

For International Class 004, the mark is in use in commerce on or in connection with **all** goods or services listed in the existing registration for this specific class; or, the owner is making the listed excusable nonuse claim.

(emphasis in original).

Furthermore, Royal Oak Sales asserted the following in its Declaration/Application for Renewal:

## **Section 8: Declaration of Use in Commerce**

*Unless the owner has specifically claimed excusable non-use, the owner, or its related company, is using the mark in commerce on or in connection with the goods and/or services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.*

## **Section 9: Application for Renewal**

*The registrant requests that the registration be renewed for the goods and/or services identified above.*

The undersigned being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

(italics in original).

Upon information and belief, the foregoing declaration was willfully false. At the time it was signed, Royal Oak Sales knew that it was not using the '298 mark in interstate commerce on wood briquets, but only charcoal briquets. Charcoal briquets include fillers, including but not limited to, anthracite coal, nitrates, and limestone. Wood briquets are 100% natural wood. Under NATURE-GLO packaging, Royal Oak Sales did not sell any wood briquets during the relevant period, knew this at the time it made the declaration, and had the requisite fraudulent intent at the time it made the declaration.

Notably, on July 21, 2010, only 20 days before filing suit, Royal Oak filed a Section 7 request to change identification of goods of the '298 mark to eliminate "wood briquets."

## **SEVENTH DEFENSE**

Defendant responds to the individually-numbered paragraphs of Plaintiff's Petition to Cancel ("Petition") as follows:

**Preamble to Petition to Cancel**

Nature's Grilling admits that Royal Oak is a Delaware Limited Liability Company with an address of 1 Royal Oak Avenue, Roswell, Georgia 30076, but denies the remaining allegations of the Preamble to the Petition to Cancel.

**Grounds for Cancellation:**  
**Likelihood of Confusion under 15 U.S.C. § 1052(d)**

1.

Nature's Grilling is without information sufficient to form a belief as to the truth of the allegations of Paragraph 1 of the Petition, and therefore denies same.

2.

Nature's Grilling admits that Petitioner is the owner by assignment of the United States Trademark Registration 1,450,298, issued August 4, 1987, for the mark NATURE-GLO covering charcoal briquets, wood chips, grill wood and firestarting fireboard, but Nature's Grilling denies that Petitioner's Registration is valid, subsisting, and in full force and effect. Nature's Grilling admits that Exhibit A purports to be a copy of Petitioner's Registration, but Nature's Grilling denies that Petitioner's Registration is valid. Nature's Grilling denies the remaining allegations of Paragraph 2 of the Petition.

3.

Nature's Grilling admits that on or about March 12, 1993, Petitioner's predecessor filed an affidavit of incontestability of the right to use the NATURE-GLO mark pursuant to Section 15 of the Lanham Act, 15 U.S.C. § 1065 and that the United States Patent Office acknowledged the Section 15 affidavit on June 18, 1993. Nature's Grilling denies the remaining allegations of Paragraph 3 of the Petition.

4.

Nature's Grilling admits that on or about August 3, 2007, Petitioner's predecessor filed a declaration of use and application for renewal of the '298 registration pursuant to Sections 8 and 9 of the Lanham Act, 15 U.S.C. §§ 1058 and 1059, respectively, and that both the declaration and application for renewal were accepted by the Trademark Office on or about August 21, 2007. Nature's Grilling denies that the declaration of use and application for renewal were valid because of their fraudulent assertions that Royal Oak was using the '298 mark in interstate commerce on wood briquets.

5.

Nature's Grilling denies that the NATURE-GLO mark has come to identify and indicate the source of Petitioner's goods to the consuming public and to distinguish Petitioner's goods from those of others. Nature's Grilling is without information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 5 of the Petition, and therefore denies same.

6.

Denied.

7.

Nature's Grilling admits that Registrant was formed in 2004. Nature's Grilling denies the remaining allegations of Paragraph 7 of the Petition.

8.

Nature's Grilling admits that the '991 Registration is for the mark NATURE'S MESQUITE (& design) and covers "[c]harcoal; [w]ood chips for smoking and grilling" and that the '991 Registration issued on March 27, 2007. Nature's Grilling further admits that the '991 Registration claims a first date of use of November 11, 2004. Nature's Grilling is without

information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 8 of the Petition, and therefore denies same.

9.

Admitted.

10.

Nature's Grilling admits that it disclaimed the "MESQUITE" portion of the mark shown in the '991 Registration. Nature's Grilling denies the remaining allegations of Paragraph 10 of the Petition.

11.

Admitted.

12.

Denied.

13.

Nature's Grilling admits that the '901 Registration is for the mark NATURE'S GRILLING (& design) and covers "[c]harcoal briquettes" and that the '901 Registration issued on March 1, 2011. Nature's Grilling further admits that the '901 Registration claims a first date of use of October 17, 2007. Nature's Grilling is without information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 13 of the Petition, and therefore denies same.

14.

Admitted.

15.

Nature's Grilling admits that it disclaimed the "GRILLING" portion of the mark shown in the '901 Registration. Nature's Grilling denies the remaining allegations of Paragraph 15 of the Petition.

16.

Admitted.

17.

Denied.

18.

Denied.

19.

Denied. Nature's Grilling denies that it needs Royal Oak's permission, approval, or consent to use or register either of the NATURE'S MESQUITE or NATURE'S GRILLING marks.

20.

Denied.

Nature's Grilling denies all other allegations contained in the Petition, including Royal Oak's Prayer for Relief, not herein specifically admitted.



WHEREFORE, having fully answered, Nature's Grilling prays for the following:

1. that judgment be entered in favor of Nature's Grilling on all counts;
2. that Royal Oak's count for cancellation of the '991 Registration be denied;
3. that Royal Oak's count for cancellation of the '901 Registration be denied; and
4. for such other and further relief as this honorable Board may deem just and proper under the circumstances.

This 11<sup>th</sup> day of April, 2011.

Respectfully submitted,

/s/ David L. Pardue

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on this date a true and correct copy of the foregoing ***ANSWER TO PETITION TO CANCEL*** has been served by first class mail, postage prepaid, upon the following counsel of record for Petitioner.

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This 11<sup>th</sup> day of April, 2011.

/s/ David L. Pardue  
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